



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/703,497      | 10/31/2000  | Anders Borgstrom     | 34650-566PT         | 2954             |

7590 03/10/2004

Richard J Moura Esq  
Jenkins & Gilchrist PC  
1445 Ross Avenue Suite 3200  
Dallas, TX 75202-2799

|          |
|----------|
| EXAMINER |
|----------|

CHOW, DOON Y

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2675     | 10           |

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/703,497

**Applicant(s)**

BORGSTROM ET AL.

**Examiner**

Dennis-Doon Chow

**Art Unit**

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2675

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5, 9, 10, 20 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Sekendur (5852434).

Sekendur discloses a pen FIG. 7 for reading positional data FIGS. 1a-2 from a specially formatted surface FIG. 1. Optical detector 19 is disclosed within the pen. In col. 5, lines 36-39, it is disclosed that during the process of writing, the surface is scanned, data is sent to a computer through a cable for storing and analyzing, and output to a screen. Sekendur further discloses a writing means for writing handwritten characters (Fig. 3).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2675

4. Claims 1-10, 14-20 and 23-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al (GB 2306669) in view of Sekendur (5852434).

Wolff discloses a method and system for entering data using an electronic reading device, comprising: an optical detector for detecting a position on a surface (Fig. 7); a wireless transmitter for transmitting data related the detected position (Fig. 5); and a separate electronic device for receiving the transmitted data and for performing a function corresponding to the transmitted data (Fig. 5). Wolff further discloses the device is used for entering text/handwriting information. Wolff further discloses the device can be used as a pointer or a mouse for navigating a display image (page 25, line 21 to page 26, lines 2), which inherently includes a menu. Wolff further discloses using a calendar manipulation form (page 6, lines 6-7), and an email form/phonebook manipulation form (page 6, lines 21 to page 7, line 7).

Wolff differs from these claims in that Wolff does not disclose detecting a predefined address pattern on a specially formatted surface.

Sekendur, in the same inputting field, discloses an optical detector for detecting a position on a specially formatted surface by detecting a predefined address pattern on the specially formatted surface.

It would have been obvious to one ordinary skill in the art to substitute Seeder's optical detector means for Wolff's optical detector means. This would have been obvious because Seeder's optical detector means is a very simple detecting device, and Wolff teaches that many different detecting devices can be used (see Figs. 7-9).

Art Unit: 2675

5. Claims 11-13, 21-22 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff in view of Sekendur as applied to claims 1-10, 14-20 and 23-30 above, and further in view of Schiller et al. (6577299).

Wolff further discloses using a facsimile system for receiving and executing the data (page 6, line 21). Wolff does not disclose the using a mobile phone.

Schiller discloses using a mobile phone for receiving, executing and faxing data information (see Fig. 21, col. 12, lines 5-22).

It would have been obvious to one ordinary skill in the art use Schiller's mobile phone in Wolff's facsimile system because of the well-recognized benefits of using a mobile phone over a land line phone.

### ***Response to Arguments***

6. Applicant's arguments filed 12/29/03 have been fully considered but they are not persuasive.

Applicant did not respond to the examiner's request presented in the last office action (see paragraph 6 of the last office action).

Applicant argues that Sekendur does not teach or suggest an area of a predefined address pattern that identifies a function of a plurality of functions. The examiner disagrees with applicant's argument because Sekendur at least teaches a function for inputting handwriting information on a display screen. An area of a predefined address pattern of Sekendur's formatted surface identifies a function for inputting handwriting information on a specific area of the display screen.

Art Unit: 2675

Applicant argues that there is no motivation to combine Wolff and Sekendur. Applicant further states that the system taught by Wolff utilizes transducers for sensing the three-dimensional forces exerted on a writing tip of the pen-like instrument and motion associated with the act of writing, there would be no motivation to utilize the data surface formatted with position-related code of Sekendur. Applicant further states that Wolff teaches the use of bar codes by the pen like instrument to determine particular pages of a document and that pressure sensors and gyroscopes are used to detect movement of the pen like instrument on the surface of a document page. The examiner disagrees with applicant's arguments. The fact that Wolff teaches using bar codes to determine particular pages of a document and gyroscopes to detect movement of the pen like instrument on the surface of a document page does not prevent Wolff and Sekendur from combining with each other. Wolff teaches using optical detectors, instead of the gyroscopes, for detecting the movement of the pen like instrument. Since Sekendur's optical detector system for detecting the movement of the pen like instrument is a lot simpler to make than Wolff's optical detector system, it would have been obvious to one ordinary skill in the art substitute Sekendur's optical detector system for Wolff's optical detector system to detect the movement of the pen like instrument.

Applicant argues that the combination of Wolff and Sekendur fails to teach, suggest, or render obvious at least one of the distinguishing features of amended independent claims 1, 20 and 31-32. The examiner disagrees with applicant's arguments because Wolff at least teaches:

A facsimile system that permits users to receive documents by means of "links" similar to WebFax. This would permit the user to forward pages to selected users by simply writing the desired destination (page 6, line 21 to page 7, line 2); and

Searching of electronic databases by writing or circling a few keywords, thumbnail descriptions, or by drawing pictures (page 7, lines 20-24).

With these teachings, it is clear that Wolff teach performing a function (the function of faxing / a mobile phone function) of a plurality of functions, the function identified by an area of a predefined address pattern that includes a detected portion of the address pattern.

### ***Conclusion***

7. An IDS was filed on 1/18/2002 (paper #6). However, there is no reference in the IDS. Applicant is respectfully request to provide copies of these references.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2675


extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis-Doon Chow whose telephone number is 703-305-4398. The examiner can normally be reached on 8:30-6:00, Alternate Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Saras can be reached on 703-305-9720. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

D. Chow  
March 5, 2004

  
DENNIS-DOON CHOW  
PRIMARY EXAMINER